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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,793	10/27/2003	Eugene M. Lee	113708.129 US1	1059
23400	7590	07/12/2006	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/692,793

Applicant(s)

LEE ET AL.

Examiner

Quoc A. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 29-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Entry 11 &amp; 17</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: Election and Response to Restriction Requirement filed on 04/21/2006, to the original application filed 05/16/2003.
2. Applicants elected invention I, without traverse which corresponds to claims 1-28 are currently pending in this application. Claims 1, 18 and 25 are independent claims.

#### *Claim Objections*

3. Claim 18 and 25 objected to because of the following informalities: Claims 18 and 25 using the language such as, "...an intellectual property environment..." which cites in the preamble of the claimed invention (see "What is the claim" pages 65 and 67); However the embodiment of claims 18 and 25 do not present any such limitation according to the claimed preamble of claims 18 and 25; even though the Applicants do mention such limitation further below in dependent claims 23 and 28. "...an intellectual property environment...". Appropriate correction is required.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. US006877137B1- filed 12/07/1999 (hereinafter Rivette).

**In regard to independent claim 1, (A) an annotation component to determine, responsive to at least one user, at least one annotation to be applied to at least one document, including a selection resource to select at least a portion of the at least one document and to associate the at least one annotation therewith,** (see Rivette at col. 13, lines 5-10) teaches components of the present invention (such as the Web annotation system 502 see Fig. 10). Also (see Rivette at col. 12, lines 55-65), Rivette Fig. 10-item 502 Web annotation system using Component Object Model (OLE), Jscript or DHTML component for controlling annotation system. Whereby enable a user to create an annotation to a web page, and links the annotation to the selected portion (see Rivette at col. 4, line 60 through col. 5 and Fig. 10 items 502, 1014A, 1016A and 1020A-1022B).

**(B) a reference component, responsive to the at least one user, to at least one of establish, traverse, indicate, and remove, at least one reference between the at least one portion and at least one of an other portion of the at least one document, an other document, and at least one other portion of the other document** (see Rivette at col. 31, lines 5-25), Rivette discloses a user interface for accessing and traverse the function provides by the web annotation system item 502. Also Rivette teaches a system and method of manipulating notes linked to Web pages, whereby these Web pages (or portions of Web pages) can be stored at a Web site or in a local file system. The method of linking notes to Web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (see Rivette at the Abstract).

It is noted that Rivette teaches a system and method of manipulating notes linked to Web pages, whereby these Web pages (or portions of Web pages). Since web pages is well known as a type of electronic documents and manipulating notes linked to Web pages, whereby these Web pages (or portions of Web pages) can be reasonably interprets as “*other portion of the other document*”.

Rivette does not explicitly teach “*a mark-up resource*”, whereby a **mark-up resource to at least one of add and edit the at least one annotation**. However, Rivette teaches notes can be grouped together under one note grouping Rivette Fig. 10 grouping table item 1090 or other database construct is used to keep track of which notes are in which note groupings. Rivette teaches that one or more of notes are grouping (i.e. adding) in a table (mark-up source), whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE, Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (see Rivette at col. 20, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Rivette’s notes grouping together under one note as grouping table item 1090 or other database construct (mark-up source) for ease of tracking of which notes are in which note groupings when linking to the appropriate portion of the target web page as selected by user using the OLE, Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (see Rivette at col. 20, lines 15-20).

**In regard to independent claim 18**, incorporate substantially similar subject matter as cited in claim 1 above, and further view of the following and is similarly rejected along the same rationale;

**computer-implemented system for providing a grouping of annotated electronic documents in an intellectual property environment** (see Rivette at col. 31, lines 5-25), Rivette discloses a user interface for accessing and traverse the function provides by the web annotation system item 502. Also Rivette teaches a system and method of manipulating notes linked to Web pages, whereby these Web pages (or portions of Web pages) can be stored at a Web site or in a local file system. Also (see Rivette at col. 39, lines 5-25), teaches the Applications of Rivette's invention includes the following,

(1) law related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies);

(2) scientific and/or engineering related projects, such as research and development projects;

(3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works;

(4) auditory and visual documents;

(5) virtual library;

(6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.;

(7) virtual classrooms;

(8) business-related Internet to research; and

(9) casual Internet use;

said system comprising: **(A) at least one merge component**, (see Rivette at co. 13, lines 5-10) teaches components of the present invention (such as the Web annotation system 502 see

Fig. 10). It is noted the Rivette teaches Web annotation system that includes components can be reasonably interprets as “*merge component*”.

**said document data including at least one element corresponding to a location of the at least one annotation within said document** (see Rivette at col. 10, lines 30-35), teaches the bi-directional hyperlink that a user associates with the part of the Web page he/she has selected.

It is noted that HyperText Markup Language (HTML) is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet; A hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment, (see Rivette at col. 2, lines 20-35).

**and to provide at least one marked-up representation of the at least one document, the at least one marked-up representation having the document data and the annotation data**, (see Rivette at col. 10, lines 30-35), teaches the bi-directional hyperlink that a user associates with the part of the Web page he/she has selected. Also Rivette teaches notes can be grouped together under one note grouping Rivette Fig. 10 grouping table item 1090 or other database construct is used to keep track of which notes are in which note groupings. Rivette teaches that one or more of notes are grouping (i.e. adding) in a table (mark-up source), whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE, Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (see Rivette at col. 20, lines 15-20).

**(B) at least one split component, responsive to said at least one marked-up representation, to extract the annotation data and the document data from the at least one**

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**marked-up representation**, (see Rivette at co. 13, lines 5-10) teaches components of the present invention (such as the Web annotation system 502 see Fig. 10). Also (see Rivette at col. 18, lines 5-5) teaches Web page A is linked to Sub-notes A, C, and D –see Rivette Fig. 29. It is noted that the Rivette's teaching of Web page A is linked to Sub-notes A, C, and D, can be reasonably interprets as "*split component*". Since (see Rivette at co. 13, lines 5-10) teaches components of the present invention (such as the Web annotation system 502 see Fig. 10). And (see Rivette at col. 12, lines 55-65), Rivette Fig. 10-item 502 Web annotation system using Component Object Model (OLE), Jscript or DHTML component for controlling annotation system. Whereby enable a user to create an annotation to a web page, and links the annotation to the selected portion (see Rivette at col. 4, line 60 through col. 5 and Fig. 10 items 502, 1014A, 1016A and 1020A-1022B).

**(C) at least one version component, to at least one of manage a history of changes and to maintain a separate version for the document data and the annotation data applied thereto**, (Rivette teaches notes can be grouped together under one note grouping Rivette Fig. 10 grouping table item 1090 or other database construct is used to keep track of which notes are in which note groupings. Rivette teaches that one or more of notes are grouping (i.e. adding) in a table (mark-up source), whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (see Rivette at col. 20, lines 15-20). Also (see Rivette at col. 39, lines 5-25), teaches the Applications of Rivette's invention includes the following,



(1) law related projects, such as licensing studies, litigation efforts, opinions of counsel (such as patentability, patent validity, and patent infringement studies);

(2) scientific and/or engineering related projects, such as research and development projects;

(3) electronic text books, handbooks, user manuals, encyclopedias, and other electronic reference works, including multimedia reference works;

(4) auditory and visual documents;

(5) virtual library;

(6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.;

(7) virtual classrooms;

(8) business-related Internet to research; and

(9) casual Internet use;

can be reasonably interprets as "*at least one version component*".

**In regard to independent claim 25**, incorporate substantially similar subject matter as cited in claims 1 and 18 above, and further view of the following, and is similarly rejected along the same rationale;

**(B) at least one of establishing, traversing, indicating, and removing at least one reference from the at least one portion to at least one of an other portion of the at least one document, an other document, and at least one other portion of the other document** (see Rivette at col. 31, lines 5-25), teaches a user interface for accessing and traverse the function provides by the web annotation system item 502. Also Rivette teaches a system and method of

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manipulating notes linked to Web pages, whereby these Web pages (or portions of Web pages) can be stored at a Web site or in a local file system. The method of linking notes to Web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoking an application, and for causing the application to load the Web page and present the selected portion (see Rivette at the Abstract).

**In regard to dependent claim 2**, incorporate substantially similar subject matter as cited in claims 1 and 18 above, and further view of the following, and is similarly rejected along the same rationale;

**a view component to select the at least one portion, and to edit, responsive to the at least one user, the at least one portion** (see Rivette at co. 13, lines 5-10) teaches components of the present invention (such as the Web annotation system 502 see Fig. 10) - "*view component*". Also (see Rivette at col. 12, lines 55-65), also (see Rivette at col. 31, lines 5-25), Rivette discloses a user interface ("*responsive to the at least one user, the at least one portion*") for accessing and traverse the function provides by the web annotation system item 502. Also Rivette teaches a system and method of manipulating notes linked to Web pages, whereby these Web pages (or portions of Web pages) can be stored at a Web site or in a local file system. The method of linking notes to Web pages operates by enabling a user to select a portion of a Web page, creating a annotation, linking the annotation to the selected portion, receiving a request from a user viewing the annotation to display the selected portion linked to the annotation, and

invoking an application, and for causing the application to load the Web page and present the selected portion (see Rivette at the Abstract).

**In regard to dependent claims 3-5, 7-10, 12-13, 15-17, 19, 23-24 and 28** incorporate substantially similar subject matter as cited in claims 1, 18 and 25 above, and are similarly rejected along the same rationale.

**In regard to dependent claim 6**, incorporate substantially similar subject matter as cited in claims 1, 18 and 25 above, and further view of the following, and is similarly rejected along the same rationale;

**the document data and the annotation data is at least one of: XML format, binary format, image data, and audio data** (see Rivette at co. 19, lines 40-50) teaches Each sub-note 1016 includes a content data that which can be any format or combination of formats, such as text, sound, video, image, executable program, tactile (such as braille), etc.

**In regard to dependent claim 11**, incorporate substantially similar subject matter as cited in claims 1, 18 and 25 above, and further view of the following, and is similarly rejected along the same rationale;

**further comprising at least one storage medium, the at least one document and the at least one reference are at least one of stored logically separate in the at least one storage medium and stored physically separate in two storage mediums including the at least one storage medium**, (see Rivette at col. 4, line 60 through col.5, line 10) teaches a user to select a portion of a Web page stored at a Web site or from a local file system (if the portion of the Web page was cached). The invention creates an annotation, and links the annotation to the selected portion. The invention receives a request from a user viewing the annotation to display the

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selected portion linked to the annotation. In response to this request, the invention makes a connection to the Web site, if a connection is not already created, and causes the Web site to send the Web page and present the selected portion. Also note that if the portion of the Web page was cached and thus stored in a local file system, then the present invention does not need to make a connection to a Web site;

**wherein at least two of the at least one annotation,** (Rivette teaches notes can be grouped together under one note grouping Rivette Fig. 10 grouping table item 1090 or other database construct is used to keep track of which notes are in which note groupings (see Rivette at col. 20, lines 15-20).

**In regard to dependent claim 14,** incorporate substantially similar subject matter as cited in claims 1, 18 and 25 above, and further view of the following, and is similarly rejected along the same rationale;

**wherein the at least one annotation includes at least one of: a pre-defined notation, a user-provided text, a user-defined attribute, a reference to a URL, and a reference to an other file** (see Rivette at co. 19, lines 40-50) teaches Each sub-note 1016 includes a content data that which can be any format or combination of formats, such as text, sound, video, image, executable program, tactile (such as braille), etc. Also (see Rivette at co. 10. line 65 through col. 11, line 10) provides an example, wherein illustrating annotation includes a reference to a URL.

**In regard to dependent claim 20** incorporate substantially similar subject matter as cited in claim 6 above, and is similarly rejected along the same rationale.

**In regard to dependent claim 21** incorporate substantially similar subject matter as cited in claims 1, 18 and 25 above, and further view of the following, and is similarly rejected along the same rationale;

**comprising a schema to identify at least one tag in the at least one element, and logic to determine tags for at least one of the document data, the annotation data, and the at least one marked-up representation** (Rivette teaches that one or more of notes are grouping in a table, whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (see Rivette at col. 20, lines 15-20).

It is noted that, the OLE standard is based on the Component Object Model (COM), Jscript or Dynamic HyperText Markup Language (DHTML) is the authoring language used to create documents or pages accessible on the Web, whereby Hyperlinks are a common function of the Internet; A hyperlink is an element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment, (see Rivette at col. 2, lines 20-35), can be reasonably interprets as *“a schema to identify at least one tag in the at least one element, and logic to determine tags”*. Since Dynamic HyperText Markup Language (DHTML) is well known as logically linking element in an electronic document that links to another place in the same document or to an entirely different document in the Web environment using tag schema in collaborating with Component Object Model (COM), Jscript using in Rivette’s web annotating system.

**In regard to dependent claims 22 and 27** incorporate substantially similar subject matter as cited in claim 14 above, and are similarly rejected along the same rationale.

**In regard to dependent claim 26** incorporate substantially similar subject matter as cited in claims 1, 18 and 25 above, and further view of the following, and is similarly rejected along the same rationale;

**(C) providing a report having a summary of the at least one portion in the at least one document and the at least one annotation associated therewith** (Rivette teaches that one or more of notes are grouping in a table ("*report*"), whereby all the notes and sub notes from the table can be links to the appropriate portion of the target web page as selected by user using the OLE standard is based on the Component Object Model (COM), Jscript or DHTML for controlling the web annotating system Fig. 10 item 502 (see Rivette at col. 20, lines 15-20).

**(D) providing a map having a summary of the at least one document, the at least one annotation, and the at least one reference** (see Rivette at col. 25, lines 50-65) teaches the user interface 504 enables a user 2404 to interact with the notes database 508 and source material 2410, representing Web pages (these Web pages may be stored in Web pages database 509). The user 2404 interacts with the user interface 504 so as to create note groupings, notes, and sub-notes, establish and modify the note grouping/note/sub-note hierarchy, establish and modify the links between sub-notes and Web page portions, and in all other ways interact with the notes database 508 and the source material 2410 (i.e. "*a map having a summary of the at least one document*").

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rivette et al.	US 20030046307A1	filed	06/22/2002
Oppedahl et al.	US006789092B1	filed	11/01/2000

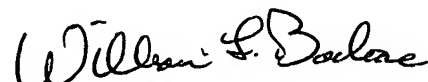
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (571) 272-4103. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on (571) -272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Quoc A. Tran*  
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*Technology Center 2176*  
*July 8, 2006*

  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**